

REMARKS

Prior to issuing an Office Action in response to this Request for Continued Examination, the Applicants' request that a personal interview with the Examiner be held. If the Examiner does not hear from Applicants' representative, he is respectfully requested to call the undersigned to schedule an interview.

This Request for Continued Examination (RCE), amendment and response are in reply to the Office Action received on July 13, 2005. In light of the amendments to the claims and attached arguments, reconsideration and indication of allowance is respectfully requested.

In the Office Action, claims 1-43 and 49-56 were rejected under 35 U.S.C. §101 as allegedly not being directed to statutory subject matter. Claims 1-3, 7-10, 13-15, 18, 19, 26, 33, 38-41 and 43 were rejected under 35 U.S.C. §102(e) as being anticipated by Fields (2002/00069154). Claims 4-6, 11, 12, 16, 20, 21, 34-36 and 42 were rejected under 35 U.S.C. §103(a) over Fields. Claims 17, 27-37 were rejected under 35 U.S.C. §103(a) over Fields in view of Slaight (2002/0077954). Claims 22-25, 37, 49-56 were rejected under 35 U.S.C. §103(a) over Fields in view of Vashistha et al. (2001/0051913).

On page 2 of the Office Action, the Examiner states in the Note Regarding Examination paragraph that the Examiner is maintaining his Official Notice rejection. Applicants' respectfully traverse for the following reasons.

The Office Action states that the arguments made in response to the allegations that features of the claim were old and well known were unpersuasive. As a result, the claimed features are considered to be admitted prior art by the Examiner. However, the Applicants' respectfully disagree for the following reasons.

The taking of Official Notice was improper at the onset of prosecution because ordinarily there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-45 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; and MPEP§2144.03(B). The Office Action provides only mere allegations that the claimed features are old and well-known. There is no evidence in the record that support the allegations of the Examiner. The lack of evidence was particularly pointed out in the Applicants' April 4, 2005 response and the Examiner was

requested to provide support for his assertion of each of the recited features, in accordance with MPEP §2144.03.

In addition, Applicants traversed the assertion that the features were well-known in the April 4, 2005 response. From line 23 of page 17 to the end of the second full paragraph on page 18 of the April 4 response, Applicants specifically provide reasons and examples of why the claimed features are not "old and well-known." Furthermore, Applicants specifically requested that the Examiner provide support for the assertions that the claimed features are old and notorious in response to the rejections of claims 4-6, 11 and 35.

In the final Office Action, the Examiner maintained the previous claim rejections using official notice without adding any support as requested and required. Accordingly, Applicants request that the rejections of claims 4-6, 11, 12, 16, 20, 21, 34-36 and 42 over Fields and the assertion of "old and well known" features be withdrawn.

The rejection of claims 1-3, 7-10, 13-15, 18, 19, 26, 33, 38-41 and 43 under 35 U.S.C. §102(e) is in error insofar as the Fields patent publication does not disclose the claimed subject matter.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

On page 3 of the final Office Action, the Office Action states that Fields teaches the features of claim 1 at page 7, paragraph 90. However, neither paragraph 90 nor any other paragraph of Fields discloses the steps of "forwarding a list of performances to the plurality of bidders" or "receiving a bid from at least one of the plurality of bidders, each received bid including a bid price determined by the bidder..." in the context of present claim 1. In fact, the bid prices of Fields are determined based on fee grids internal to the system by the request for proposal (RFP) system itself not by the bidder (see paragraphs 77, 78 and 80; Figs. 15 and 21). In other words, the bidders do not have to enter a price because Fields' RFP system provides a price to the bidders, who then have the opportunity to accept, reject or delete the desired price set by the requester (Fields paragraph 88).

It is respectfully submitted that Fields fails to disclose each of the features recited in

claim 1. Therefore, Fields cannot reasonably be said to anticipate Applicants' claimed invention. Accordingly, claim 1 is believed to be patentably distinguishable over Fields, and it is respectfully requested that the rejection of claim 1 be withdrawn.

Claims 2, 3, 7-10, 13-15, 18, 19, 26, 33, 38-41 and 43 depend from claim 1 and include all the features of claim 1 plus additional features which are not taught or suggested by the Fields document. For example, claim 14 recites the feature of determining a plurality of bidders which to forward the list of performances is based on a history of past performance by the bidders. Fields does not disclose such a feature. These claims also further remove the present invention from the applied art, but discussion thereof will not be belabored for sake of brevity.

For the above reasons, the rejections of claims 1-3, 7-10, 13-15, 18, 19, 26, 33, 38-41 and 43 under 35 U.S.C. §102(e) should be withdrawn.

In the rejection of claim 10, the Office Action states that "it is noted that since the database comprises a price term independent of region (national price) and a regional price, it is inherent that the database comprises a regional dependent price correction term".

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in the original).

However, claim 10 recites that the database comprises prices independent of the region in which the predetermined performance is to be affected, and wherein the database further comprises at least one regionally dependent price correction term for a plurality of regions in which the predetermined performance is to be affected. The Office Action implicitly admits that Fields discloses no such features, but the Office Action also asserts that such features would be inherent given a price term independent of region and a regional price. However, for this particular feature to be "inherent", it must necessarily be present for determining an estimated regional price. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999).

In contrast to the assertions of the Office Action, Fields discloses that such a feature is not required, and therefore is not inherent, for determining regional prices. Fields can

determine regional pricing based on fee grids which include both regional and national (independent of region) fees, with no disclosure of a regionally dependent price correction term (see Fields at paragraphs 78, 80, 88).

The Applicants respectfully note that the final Office Action has relied on a published application to Fields to reject claims 1 - 3, 7 - 10, 13 - 15, 18, 19, 26, 33, 38 - 41, and 43 under 35 U.S.C § 102, but has presented no analysis regarding where Fields fully anticipates the features recited in claims 2, 3, 7-10, 13-15, 18, 19, 26, 33, 38-41, and 43, contrary to the requirements of 37 C.F.R. § 1.104(c). In fact, the final Office Action is completely silent regarding why or how Fields anticipates the features of claims 2, 7-9, 13-15, 18, 19, 26, 33, and 38-41. Accordingly, it is respectfully requested that the rejections of claims 2, 7-9, 13-15, 18, 19, 26, 33, and 38-41 be withdrawn.

On page 4 of the Office Action, claims 4-6, 11, 12, 16, 20, 21, 34-36 and 42 have been rejected under 35 U.S.C. §103 as being unpatentable over Fields.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the cited references must have some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Fields allegedly discloses and renders obvious claim 11, which recites utilizing the regionally independent prices and the regional dependent price correction term for determining an estimated price. However, Fields expressly discloses fee grids comprising both regional pricing and national (regionally independent) pricing (paragraph 77, 80). Therefore, there would have been no need to modify Fields to provide for regional pricing in the manner suggested by the Office Action and as recited in claim 11. The Office Action further asserts that the features of claim 11 would have been an obvious design choice because, in the unsupported assertion of the Office Action, “it does not appear that this particular method of determining regional prices solves a particular problem or is for a specific purpose.” However, whether a feature solves a particular problem or is for a specific purpose does not constitute grounds for rejection under 35 U.S.C §103. Furthermore, the Office Action does not identify where the Fields expressly or impliedly suggests that

adapting a regional price correction to an independent price correlates to database maintenance. A review of the Fields disclosure does not reveal any suggest or motivation to modify his system to perform the method steps recited in claim 11. Accordingly, the rejection of claims 11 and 12 should be withdrawn.

As a further example, claim 35 recites automatically generating a contract list of performances after selecting the bid. The contract list of performances is the list of performances with the prices for each performance being included based on the prices stated in the selected bid. Such a feature would not have been obvious in view of Fields because the Fields system generates the prices for the list of performances before the request for proposals are sent to the attorneys and, therefore, before any attorney is selected for performing the work (see Fields at paragraphs 77, 78, 87, and 88).

Accordingly, it is respectfully requested that the rejections of claims 4-6, 11, 12, 16, 20, 21, 34-36 and 42 be withdrawn.

Should any questions arise in connection with this application, the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

BUCHANAN INGERSOLL PC

Date: November 14, 2005

By: Martin E. Miller
Martin E. Miller
Registration No. 56,022

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620